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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77129912
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Applied for Mark	GRAN HABANO
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

In re U.S. Trademark Application)	
)	
Applicant: Santa Cruz Tobacco Co., Inc.)	Examining Attorney: David C. Reihner
)	
Serial No.: 77/129,912)	Law Office: 111
)	
Filed: March 16, 2007)	Our Ref. No.: 130171.010100
)	
Mark: GRAN HABANO)	

APPLICANT'S REPLY BRIEF

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APPLICANT’S REPLY BRIEF

Applicant Santa Cruz Tobacco Co., Inc. (“Applicant”) hereby submits its reply brief in support of its appeal in this matter, and responds to the Examining Attorney’s Appeal Brief, dated December 30, 2014 (the “Examiner’s Brief”). As shown herein, the Examiner’s Brief falls far short of presenting any argument or evidence that could sustain the Final Refusal or Denial of Applicant’s Request for Reconsideration.

I. INTRODUCTION

The Examiner’s Brief relies on two principal arguments, neither of which is supported by the record or the Board’s precedent.

First, after having completely ignored during the prosecution of this application the declarations and evidence submitted by Applicant in support of its Request for Reconsideration, the Examiner now claims for various reasons (none of which has merit) that the declarations “are to be given little weight.” At no point in his brief does the Examiner even attempt to address the substance of those declarations.

Second, the Examiner continues to assert in the face of Applicant’s substantial and uncontroverted evidence that the presumption of materiality under the holdings of

Guantanamera and *Jonathan Drew* should apply here regardless of the factual record before the Board. In essence, the Examiner urges the Board to adopt a *per se* rule against registration of marks for cigars that evoke Cuba. Neither of those cases stands for such a proposition. Indeed, the Examiner's position, if accepted, would turn the Board's precedent on its head by making the rebuttable presumption of materiality irrebuttable. In short, the Examiner's attempt to argue for a "one-size-fits-all" approach for deciding the present appeal is without merit and should be rejected.

II. ARGUMENT

A. The Board Should Reject the Examining Attorney's New Arguments Concerning the Weight and Sufficiency of the Applicant's Rebuttal Evidence

Having failed to consider or even acknowledge during examination the declarations and evidence submitted by Applicant with its Request for Reconsideration, the Examiner in his brief now attacks that evidence by raising new arguments regarding its weight and sufficiency. The Board should not consider these newly raised arguments. *See In re Future Ads LLC*, 2012 WL 3224733, *4 (TTAB 2012) (reversing refusal to register where examining attorney raised a new argument for the first time in her appeal brief "at a point where prosecution and examination had long closed."). Notably, the Board in *Future Ads LLC* took a dim view of this tactic, stating that "we view the examining attorney's actions as poor examination practice and strongly urge that such a practice not be followed in the future." *Id.* at *2.

Here, as in *Future Ads LLC*, "it is troubling that the examining attorney never put [Applicant] on notice" during examination that he was contesting the weight or sufficiency of the declarations submitted by Applicant. *Id.* at *4. Indeed, the Examiner even stated, erroneously, that Applicant did not "provide any new . . . evidence with regard to the outstanding issue in the final Office Action." Denial at pp. 2-3. It is therefore manifestly unfair for Applicant to be

forced to address, in its reply brief in this appeal, arguments that for unexplained reasons were never previously raised by the Examiner.

Even if the Board were to consider the Examiner's belated attack on the declarations submitted by Applicant, the Board should nonetheless reject the Examiner's arguments. It is well-established that the Board "generally takes a somewhat more permissive stance with respect to the admissibility and probative value of evidence in an *ex parte* proceeding than it does in an *inter partes* proceeding." TBMP § 1208. To this end, the Board relaxes the technical requirements for evidence and "focuses instead on the spirit and essence of the rules of evidence." *Id.* Thus, the Board has routinely upheld the use of declarations as "an established method for the introduction of evidence in an *ex parte* proceeding." *Id.* See, e.g., *In re Data Packaging Corp.*, 453 F.2d 1300, 172 U.S.P.Q. 396, 399 (CCPA 1972) (fact that the affidavits were drafted by the applicant's attorney and were practically identical in wording detracts little or nothing from their sufficiency to make out a *prima facie* case of trademark recognition); and *In re Pingel Enterprise Inc.*, 46 U.S.P.Q.2d 1811, 1822 n.15 (TTAB 1998) (fact that applicant's attorney assisted consumers in preparing statements -- form letters -- to show acquired distinctiveness does not make the submissions less honest or valid).

Further, the Board has found that even "form" declarations are sufficiently probative evidence to establish consumer perception of a designation as a trademark, rejecting the examining attorney's contention that the declarations were not persuasive because of their identical wording. See *In re Petersen Manufacturing Co., Inc.*, 229 U.S.P.Q. 466, 1986 WL 83664 at *2-3 (TTAB 1986) (reversing refusal to register, finding that "[t]here is nothing in the record to contradict these declarations and nothing to indicate that the statements made in the declarations are anything other than the honest conviction of the declarants."); *In re Benetton*

Group S.p.A., 48 U.S.P.Q.2d 1214, 1217 (TTAB 1998) (accepting “form” declarations from individuals so long as they include background information and their experience with the applicant so that the Board can assess their probative value).¹

Here, the uncontroverted declarations of Applicant’s distributors and consumers are probative evidence that the relevant purchasers do not consider the term “habano” to be a material factor in their decision to purchase Applicant’s GRAN HABANO cigars. Each declarant provides information regarding his or her (1) years of experience working in the cigar industry or as a cigar consumer, (2) knowledge of Applicant and its GRAN HABANO cigars, (3) the level of sophistication and demographics of customers for premium cigars in general and Applicant’s cigars in particular, and (4) the buying preferences of Applicant’s customers. As a result, each declaration provides a sufficient evidentiary foundation for the declarants’ statements contained therein.

It is telling that the Examiner fails to address the substance of the declarations, nor does he deny that they rebut the presumption of materiality upon which the Examiner so heavily relies. The best the Examiner can do is to argue that the declarations be given little weight. As shown below, none of the Examiner’s arguments has merit.

First, relying upon a 1961 case, the Examiner contends that the declaration of Applicant’s President, George A. Rico, should be given little weight “because the officer is an interested party to the trademark matter at hand.” Examiner’s Brief, p. 9. The Examiner thus overlooks the recent and far more relevant precedent where the Board accepted declarations from the

¹ Applicant’s declarations include, in most instances, information regarding the declarant’s particular knowledge of and experience with cigars and cigar brands, including Applicant’s GRAN HABANO cigars. As such, they are distinct from the “form” declarations at issue in the cases cited above.

applicant's officers to rebut the examining attorney's finding of a goods-place association. *See In re Brouwerij Nacional Balashi, NV*, 80 U.S.P.Q.2d 1820, 1825-26 (TTAB 2006).

Second, with respect to the declarations from Applicant's distributors and retailers, the Examiner's reliance on *In re Semel*, 189 U.S.P.Q. 285 (TTAB 1975) is wholly misplaced. In stark contrast to the declarations here, the Board in *In re Semel* observed that there was "nothing in the statements submitted by the applicant that show that the officials who signed them are involved with the actual day-to-day sale of applicant's goods or are otherwise in such a position as to have personal knowledge." *Id.* at 288. Here, each of the distributor/retailer declarants speak to his or her personal experience in selling Applicant's GRAN HABANO cigars and provide their first-hand knowledge of their consumers' buying preferences based on their many years of working in the cigar industry and their direct interaction with the consumer. *See* Declarations of Retailers and Distributors submitted as Exhibits D1-D12 to Applicant's Request for Reconsideration. As a result, these distributors and retailers are well-qualified to attest to the fact that, based on their decades of industry experience, the term "habano" in Applicant's mark is not a material factor in their customers' purchasing decisions.

Third, the Examiner seeks to belittle the probative value of the declarations from Applicant's customers by claiming that the declarations "are a form of survey" and thus must be evaluated based on factors used to assess consumer surveys. Examiner's Brief at pp. 9-10. The case of *In re Hotels.com LP*, 91 U.S.P.Q.2d 1532, 573 F.3d 1300 (Fed. Cir. 2009), cited by the Examiner, does not support this proposition. In *Hotels.com*, the applicant submitted declarations from customers, vendors, and competitors, and also submitted a "Teflon" consumer survey. The Court considered the declarations and survey separately, and in no way held that the declarations

were “a form of survey” or should be treated as such. *See In re Hotels.com LP*, 573 F.3d at 1304-06. Thus, the Examiner’s attack on the customer declarations is completely misguided.

Finally, the Examiner urges the Board to discount the probative value of the declarations because “there is no indication that the declarants are knowledgeable in trademark law or that they otherwise understand and are familiar with such technical concepts as mere descriptiveness, distinctiveness, and the definition of a trademark.” Examiner’s Brief, pp. 9-10 (quoting *In re Pennzoil Products Co.*, 20 U.S.P.Q.2d 1753, 1759 (TTAB 1991)). This contention is unavailing. Unlike the declarants in *Pennzoil Products*, the declarants in the present case do not address the concepts of mere descriptiveness, distinctiveness, definition of a trademark, or other technicalities of trademark law. Rather, they attest to whether the use of a certain term – namely, “habano” – in Applicant’s mark is a material factor in their decision to purchase Applicant’s cigars. As sophisticated cigar professionals and purchasers, each of the declarants is competent to attest to this fact; no specialized knowledge of trademark law is required.

B. The Examiner’s Brief Fails to Address the Direct Evidence of Non-Materiality

Conspicuously absent from the Examiner’s Brief is any argument regarding the direct evidence of record in this proceeding that the relevant purchasers do not view the term “habano” in Applicant’s mark as a material factor in their decision to purchase Applicant’s cigars. In particular, the Examiner does not address, and appears not to dispute, that Applicant’s direct evidence rebuts the Examiner’s presumption of materiality. As a result, the Examiner’s Brief merely rehashes the same arguments he presented in the Final Refusal and the Denial. *See* Examiner’s Brief, pp. 11-13. Applicant has addressed those arguments at length in its Appeal Brief, to which the Board is respectfully referred.

At its core, the Examiner's position is that the Board should affirm the refusal to register regardless of the evidence of record. None of the cases relied upon by the Examiner – *Guantanamera*, *Jonathan Drew*, or *Anncas* – stands for such a proposition. Indeed, those cases recognize that the presumption of materiality is rebuttable. During examination, the Examiner gave no consideration to Applicant's substantial (and probative) rebuttal evidence, and has maintained that approach in this appeal. To deny Applicant a fair and thorough assessment of its rebuttal evidence would render meaningless the rebuttable presumption of materiality and create a *per se* rule against the registration of a mark that evokes Cuba, regardless of whether the materiality requirement of Section 2(e)(3) is satisfied. The Board should not countenance such a result here.

III. CONCLUSION

For the foregoing reasons and those set forth in Applicant's Appeal Brief, Applicant respectfully requests that the refusal under Section 2(e)(3) be reversed and that the Board direct the mark GRAN HABANO to be approved for publication.

Respectfully submitted,

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